



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,378	11/08/2001	Ola Sandstrom	3782-0193P	5140

2292 7590 06/14/2004

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

MUHEBBULLAH, SAJEDA

ART UNIT	PAPER NUMBER
----------	--------------

2174

DATE MAILED: 06/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/986,378

Applicant(s)

SANDSTROM ET AL.

Examiner

Sajeda Muhebbullah

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-11 and 14-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Regarding claim 1, the phrase "for instance" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

6. The term "some" in claim 8 is a relative term which renders the claim indefinite. The term "some" is not defined by the claim, the specification does not provide a

Art Unit: 2174

standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

7. Regarding claim 14, the phrase "in such manner" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3, 8, 10, and 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Sklarew (US 4,972,496).

As per claim 1, Sklarew teaches a filing appliance comprising means for holding a plurality of sheets (col.3, lines 37-40) characterized by at least one input field (Fig.12c) which is provided with a position-coding pattern (col.5, lines 61-64) and is adapted to be filled in by means of a drawing device (col.5, lines 57-60) which records, using said position-coding pattern, positions in the input field in order to digitally (col.7, line 38) record information entered in the input field (col.5, lines 61-67), and an initiation icon provided with a position-coding pattern (Fig.10, *SAVE*; Fig.12F, *INSERT*), a marking of the initiation icon by means of the drawing device being adapted to initiate an operation in a computer system communicating with the drawing device, in which operation an information object is created (col.11, lines 41-43; col.12, lines 55-57), which is identifiable at least by means of information entered in the input field.

Art Unit: 2174

As per claim 2, Sklarew teaches the input field to be adapted to be filled in at least with text (col.12, lines 28-29).

As per claim 3, Sklarew teaches the input field to be adapted to be filled in at least with an illustration (col.4, lines 33-35).

As per claim 8, Sklarew teaches a filing appliance wherein in at least some sheets in a subset of said plurality of sheets are provided with a position-coding pattern, so that information filled in on a sheet in the subset can be recorded by means of said drawing device (col.5, lines 61-64) as a digital graphical input (col.7, lines 37-38), and a send icon provided with a position-coding pattern (Fig.12F, *INSERT*), a marking of the send icon by means of the drawing device initiating an operation in a computer system (col.12, lines 55-57), in which operation graphical inputs entered on the sheet are transferred to the computer system (col.3, lines 42-45) and optionally on to an external computer system (col.10, lines 53-57).

As per claim 10, Sklarew teaches a filing appliance wherein said information object comprises a file (col.10, lines 23-25; col.12, lines 55-57; *added text inserted into file*).

Independent claim 12 is similar in scope to independent claim 1, and is therefore rejected under similar rationale.

As per claim 13, Sklarew teaches the computer system to be integrated with the drawing device (Fig.2; col.5, lines 59-60).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2174

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sklarew (US 4,972,496) in view of Gough et al. ("Gough", US 5,603,053).

As per claims 4-5, Sklarew teaches a filing appliance wherein in at least a subset of said plurality of sheets are provided with a position-coding pattern so that information filled in on a sheet in the subset by means of said drawing device (col.5, lines 61-64) is recordable as a digital graphical input (col.7, lines 37-38), the filing appliance comprising a number of icons (Fig.10). However, Sklarew does not disclose the filing appliance to comprise of a number of appearance icons, a marking of an appearance icon by means of said drawing device being adapted to give the digital graphical input a visual property. Gough teaches an appliance to be input by a drawing device wherein the appliance comprises a number of appearance icons (Fig.2b, *icons 42, 44, 46*) which when marked provide the input a visual property relating to stroke weight (col.6, lines 23-28). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Gough with Sklarew in order visually enhance the input of the user.

12. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sklarew (US 4,972,496) and Gough et al. ("Gough", US 5,603,053) in view of Microsoft PowerPoint ("PowerPoint").

As per claim 6, Sklarew and Gough teach the drawing device to give the digital input a visual property but does not disclose the visual property to relate to line color. However, PowerPoint teaches a drawing device adapted to give the input a line color

Art Unit: 2174

(page 2, line color icon). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of PowerPoint with the teaching of Sklarew and Gough in order to visually enhance the input of the user.

13. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sklarew (US 4,972,496) in view of Borgstrom et al. ("Borgstrom", US 6,738,053).

As per claim 7, Sklarew teaches a filing appliance which comprises an address field provided with a position-coding pattern (Fig.2). However, Sklarew does not disclose an order icon, a marking of the order icon being adapted to initiate an operation in the computer system, which operation performs an order of another filing appliance to be delivered to the address entered in the address field. Borgstrom teaches a system for initiating functions using a drawing device wherein an order of additional sheets can be initiated through an icon (col.7, lines 51-57). It would have been obvious to one of ordinary skill in the art at the time of the invention to include Cleveland's teaching with Sklarew's apparatus in order to provide a quick and easy method of ordering appliances.

14. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sklarew (US 4,972,496) in view of Wildermuth (US 5,950,188).

As per claim 9, Sklarew teaches a filing appliance wherein said information object comprises a database (col.11, line 58; *character object added to database*). However, Sklarew does not explicitly disclose the database to be in the form of a table. Wildermuth teaches a computer system wherein a table in a database stores and retrieves information (col.5, lines 41-42). It would have been obvious to one of ordinary skill in the art at the time of the invention to include Wildermuth's teaching with Sklarew

Art Unit: 2174

appliance to increase the flexibility of modifying the data and make the database more user-friendly (Wildermuth, col.5, lines 55-58).

15. Claims 11, 14-15, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sklarew (US 4,972,496) in view of Lamming (US 5,535,063).

As per claims 14-15 and 17, Sklarew teaches a filing appliance comprising an archiving icon (Fig.10, *SAVE*), a marking of the archiving icon by means of the drawing device initiates an operation wherein position information corresponding to strokes of the drawing device is transmitted from the drawing device to the computer system (col.5, lines 61-64; abstract, lines 6-8). However, Sklarew does not explicitly disclose the position information to be of strokes generated after a reference time point which is to be set to the current time in connection with the transmission of the position information and stored in the computer system. Lamming teaches a system of time-stamping strokes entered by a drawing device which are then stored in the computer system (col.2, lines 8-20). It would have been obvious to one of ordinary skill in the art at the time of the invention to include Lamming's teaching with Sklarew's system in order to provide a fast and efficient method of locating previously stored information.

Claim 11 is similar in scope to claim 14, and is therefore rejected under similar rationale.

16. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sklarew (US 4,972,496) and Lamming (US 5,535,063) in view of Morishita et al. ("Morishita", US 6,335,727).

As per claim 16, the system of Sklarew and Lamming teaches the reference time point to be stored in the computer system, however, does not teach the reference time

Art Unit: 2174

point to be stored in the drawing device. Morishita teaches a drawing device with the ability to store time points (col.13, lines 34-38). It would have been obvious to one of ordinary skill in the art at the time of the invention to include Morishita's teaching with the system of Sklarew and Lamming in order to provide increased portability of positional information.

17. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sklarew (US 4,972,496) and Borgstrom et al. ("Borgstrom", US 6,738,053).

As per claim 18, Sklarew teaches a method for arranging incoming information in a computer system, characterized in

that a first information object in the computer system is open vis-à-vis an application in the computer system, the first information object being related to a first filing appliance (col.12, lines 43-57);

that position information , which arises when a drawing device is moved over a position-coding pattern is received by the computer system (col.5, lines 61-64), wherein the position information which is generated at a time point *t* (*time is continuous therefore inherent for a time to exist in which the position information is generated*) comprises information that is intended to make open a second information object vis-à-vis the application in the computer system, (col.12, lines 43-57; *a second nurse can open a record of second patient via the application*) and

that position information generated before said time point *t* is inserted in the first information object whereas position information generated after said time point *t* is inserted in the second information object (*the information inserted by the first nurse is inserted into the first patient's records which corresponds to before time point t, the time*

Art Unit: 2174

of opening the second patient's records, at which point the second nurse inserts information into the second patient's records).

However, Sklarew does not explicitly disclose the second information object to be related to a second filing appliance. Borgstrom teaches a method of having multiple users using different appliances for an application (col.12, lines 61-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to include Borgstrom's teaching with Sklarew's method in order to distinguish the inputs from multiple users of an application.

Claims 19-20 are individually similar in scope to claim 18, and are therefore rejected under similar rationale.

Art Unit: 2174

Communications

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sajeda Muhebbullah whose telephone number is (703) 305-0720. The examiner can normally be reached on Monday - Thursday from 8:00 am to 5:30 pm (EST). The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid, can be reached on (703) 308-0640.

The fax number for the organization where this application or proceeding is assigned are as follows:

(703) 746-7238 [After Final Communication]

(703) 872-9306 [Official Communication]

(703) 746-9915 [For status inquiries, Draft Communication]

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Sajeda Muhebbullah
Patent Examiner
June 7, 2004

Kristine Kincaid
KRISTINE KINCAID
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100